

**REMARKS**

Claims 1-12, 14-43 and 45-63 are pending in the application.

Claims 1-10, 14-41 and 45-63 have been rejected.

Claims 11, 12, 42 and 43 have been objected to.

Claims 1, 16-17, 32, 61 and 63 have been amended, as set forth herein.

Claim 62 has been canceled, without prejudice.

**I. ALLOWABLE SUBJECT MATTER**

The Applicant thanks the Examiner for the indication that Claims 11-12 and 42-43 would be allowable if rewritten in independent form. Because the Applicant believes that Claims 11-12 and 42-43 depend from allowable base claims, the Applicant prefers not to rewrite Claims 11-12 and 42-43 in independent form, at this time.

**II. REJECTION UNDER 35 U.S.C. § 102**

Claims 1-8, 14-17, 23, 27-29, 31-39, 45-46, 52, 56-58 and 60-63 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,487,170 to Chen et al. (hereinafter "Chen"). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566,

1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Independent Claims 1, 32, 61 and 63 (as amended) recite method, apparatus and article in which a throughput measurement request is transmitted that causes a trace to propagate via a path between the origination terminal and the destination terminal. In response to the trace, information is received that identifies one or more network resources on the path between the origination terminal and the destination terminal. Performance characteristics of the identified one or more network resources is monitored to generate a throughput measurement of the path. Chen fails to disclose these elements/features of Applicant's independent claims.

Chen discloses that each local bandwidth broker running on an intermediate node along the path between an ingress edge device and an egress edge device evaluates admission criteria for a request (REQUEST message) and makes it's own determination of whether to accept or reject the request. See Chen, Col. 8, Line 54 - Col. 9, Line 10. If the request is rejected by any of the intermediate nodes, the intermediate node either sends a reject message to the ingress edge device or drops the request message to prevent the egress edge device from generating an accept message. See Chen, Col. 9, Lines 11-18.

Chen does not disclose measuring throughput in a path between an origination and destination terminal by transmitting a throughput measurement request wherein the throughput measurement request causes a trace to propagate between the origination terminal and the

destination terminal, which then results in receiving the identity of one or more network resources in the path and monitoring performance characteristics of these identified network resources to generate a throughput measurement, which is then used to accept or reject the call request. See, Claims 1, 32, 61 and 63. As such, Chen fails to disclose every element/feature of Applicant's invention arranged as they are in amended independent Claims 1, 32, 61 and 63 (and Claims 2-8, 14-17, 23, 27-29, 31, 33-39, 45-46, 52, 56-58 and 60 depending therefrom).

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(e) rejection of Claims 1-8, 14-17, 23, 27-29, 31-39, 45-46, 52, 56-58 and 60-63.

### III. REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-10, 14-17, 19-41, 45-46 and 48-63 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,515,964 to Cheung et al. (hereinafter "Cheung") in view of U.S. Patent No. 6,404,738 to Reininger et al. (hereinafter Reininger). Claims 18 and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheung and Reininger in view of U.S. Patent No. 6,356,545 to Vargo et al (hereinafter "Vargo"). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP §

2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

The Office Action concedes, on Page 3 of the Office Action, that “Cheung does not disclose transmitting a throughput measurement request, the throughput measurement request causing a trace packet to propagate between the origination terminal and the destination terminal and receiving a throughput measurement response in response to the transmitting of the throughput measurement request.”

Reininger discloses that QoS Controllers on the network switches are each capable of processing a renegotiation request for bandwidth allocation for an existing connection. See Reininger, Col. 8, Lines 22-58. If a QoS Controller determines that the satisfaction index for all active connections can be achieved once the requested bandwidth is allocated, the QoS Controller reserves the requested bandwidth and informs the source that the request was accepted. See Reininger, Col. 9, Lines 55-60, and Col. 13, Lines 5-9.

Reininger does not disclose transmitting a throughput measurement request wherein the throughput measurement request causes a trace packet to propagate via a path between the origination terminal and the destination terminal. See, Claims 1, 32, 61-63.

In addition, with respect to the new amendments to the claims, Applicant respectfully submits that none of the references either alone, or in combination, disclose, teach or suggest all the features/elements of Claims 1, 32, 61 and 63 (and their dependent claims). Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejection of Claims 1-10, 14-41 and 45-63.

IV. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

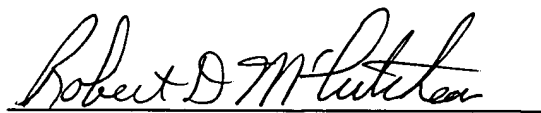
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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